



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,111	06/24/1999	YASUMASA ONO	35.13605	8674

5514 7590 05/14/2002

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HOOSAIN, ALLAN

ART UNIT PAPER NUMBER

2645

DATE MAILED: 05/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/344,111

Applicant(s)

ONO, YASUMASA

Examiner

Allan Hoosain

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment A, 2/1/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- ✓ If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-5, 11-12, 14-15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rao** (US 5,896,165) in view of **Skarbo et al.** (US 5,778,053).

As to Claim 1, with respect to Figures 1-3, **Rao** teaches a communication apparatus capable of receiving communication information from the outside, comprising:

call pick up (discrimination means) for discriminating presence or absence of reception of the communication information (Figure 2, label 32); and

control codes (control means) for executing control, in case of reception of the communication information, to set a recording apparatus, capable of recording the communication information, in a state capable of recording (Figure 2, label 36, 60, 62);

wherein said control means executes control, in a case where the communication information is judged as the image signal, to cause the recording apparatus to start recording (Col. 2, lines 52-54);

Rao does not teach the following limitation:

“and to record the recording start point at the start of recording”

However, it is obvious that Rao suggests this limitation. This is because Rao teaches recording and playing back video messages which suggests start times for the recorded video messages. Skarbo teaches selecting and showing the first frame (start time) of a video message to be played back (Col. 8, lines 16-20, Figure 6, label 620 and Figure 7, label 720). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add recording start times to Rao's invention as taught by Skarbo's invention in order to provide the play back of video messages from the first frame.

As to Claims 2,12, Rao teaches a communication apparatus according to claim 1, wherein said discrimination means has a function of:

discriminating whether the communication information is an image signal, and said control means executes control, in case the communication information is judged as the image signal, to cause the recording apparatus to start recording (Figure 2, label 60).

As to Claims 5,15, Rao teaches a communication apparatus according to claim 1, wherein said recording apparatus includes transmission means for transmitting said communication information, and said control means executes control, through said transmission means, to set the recording apparatus in a state capable of recording (Figure 1, labels 78,79,80).

As to Claim 11, with respect to Figures 1-3, Rao teaches a communication information recording method adapted for use in a communication apparatus capable of receiving communication information from the outside, the method comprising:

a discrimination step of discriminating presence or absence of reception of the communication information (Figure 2, labels 30-32); and

a control step of executing control, in case of reception of the communication information, to set a recording apparatus, capable of recording the communication information, in a state capable of recording (Figure 2, labels 36,60,62);

wherein said control step includes executing control, in a case where the communication information is judged as the image signal, to cause the recording apparatus to start recording (Col. 2, lines 52-54);

Rao does not teach the following limitation:

“and to record the recording start point at the start of recording”

However, it is obvious that **Rao** suggests this limitation. This is because **Rao** teaches recording and playing back video messages which suggests start times for the recorded video messages. **Skarbo** teaches selecting and showing the first frame (start time) of a video message to be played back (Col. 8, lines 16-20, Figure 6, label 620 and Figure 7, label 720). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add recording start times to **Rao's** invention as taught by **Skarbo's** invention in order to provide the play back of video messages from the first frame.

As to Claim 21, with respect to Figures 1-3, **Rao** teaches a computer readable memory medium storing a program for executing a communication information recording method adapted for use in a communication apparatus capable of receiving communication information from the outside, the method comprising

a discrimination step of discriminating presence or absence of reception of the communication information (Figure 1 and Figure 2, labels 30-32); and

a control step of executing control, in case of reception of the communication information, to set a recording apparatus, capable of recording the communication information, in a state capable of recording (Figure 2, labels 36, 60, 62);

wherein said control step includes executing control, in a case where the communication information is judged as the image signal, to cause the recording apparatus to start recording (Col. 2, lines 52-54);

Rao does not teach the following limitation:

“and to record the recording start point at the start of recording”

However, it is obvious that **Rao** suggests this limitation. This is because **Rao** teaches recording and playing back video messages which suggests start times for the recorded video messages. **Skarbo** teaches selecting and showing the first frame (start time) of a video message to be played back (Col. 8, lines 16-20, Figure 6, label 620 and Figure 7, label 720). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add recording start times to **Rao**'s invention as taught by **Skarbo**'s invention in order to provide the play back of video messages from the first frame.

As to Claims 4,14, **Rao** teaches a communication apparatus according to claim 3, wherein said control means executes control, in case the communication information is judged as the image signal, to cause said recording apparatus to start recording (Figure 2, labels 50 and 52).

Rao does not teach the following limitation:

Art Unit: 2645

“and to record identification information for recognizing the recording start point at the start of recording”

Skarbo teaches the limitation (Col. 8, lines 4-34). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add start time capability to **Rao**'s invention for playing back recordings as taught by **Skarbo**'s invention in order to provide tracking and status information.

3. Claims 6-10 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rao** in view of **Gerszberg et al.** (US 6,052,439).

As to Claims 6,16, **Rao** teaches a communication apparatus according to claim 5:

Rao does not teach the following limitation:

“wherein said transmission means transmits said communication information according to the IEEE 1394 based interface standard”

Gerszberg teaches the limitation (Col. 5, lines 1-9). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add IEEE 1394 capability to **Rao**'s invention for providing networking as taught by **Gerszber**'s invention in order to provide desirable network interfaces.

As to claims 7,17, **Rao** teaches a communication apparatus according to claim 6, wherein said communication apparatus is applicable to a message telephone (Figure 1, labels 62,64).

As to claims 8-9,18-19, **Rao** teaches a communication apparatus according to claim 1.

Rao does not teach the following limitation:

“wherein said recording apparatus is a magnetic recording apparatus”

Gerszberg teaches the limitation (Col. 8, lines 7-17). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add magnetic storage capability to **Rao**'s invention for providing storage as taught by **Gerszber**'s invention in order to provide appropriate storage of information.

As to Claims 10,20, **Rao** teaches a communication apparatus according to claim 8, wherein said recording apparatus is a hard disk device (Col. 1, lines 62-66).

Response to Arguments

4. Applicant's arguments filed in the Remarks of Amendment A have been fully considered but they are not persuasive because of the following:

It is not obvious to combine **Rao** with **Skarbo** because **Skarbo** does not teach recording start times of video messages.

Examiner respectfully disagrees. This is because of the reasons given in the instant rejection. Since **Rao** teaches recording and playback of video messages, it is obvious that the start times of the video messages are recorded. **Skarbo** teaches that tracking selects and shows the first frame of a video message. The first frame teaches that start times (first frame) were recorded.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kim et al. (US 5,905,843) teach a system for selective recording of TV programs.

Blonder (US 5,559,868) teach a telephone device for sending and receiving video images.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

Art Unit: 2645


(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Allan Hoosain
Primary Examiner
5/10/02